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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,524	09/30/1999	EUGENE M. LEE	K7565.0001/P001	5499

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,524

Applicant(s)

LEE, EUGENE M.

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Claim 57 was added to application 09/409,524; Claims 1-57 are now pending.

Drawings

2. The Changes made to the drawings (fig.2) have been reviewed and are approved.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over InventNet.com (www.inventnet.com, 11/7/1996), in view of The World Intellectual Property Organization (PCT-Easy, User Reference Manual, January 1999, <http://pcteasy.wipo.int/en/index.html>).
5. As per independent Claims 1, 5, 15, 22, 25, 33, 41, 44, 52, 54 and 56, InventNet.com discloses a method of operating an information service (information system, one-stop intellectual property filing service, a computer implemented method, and/or an intellectual property filing preparation system) to facilitate preparation of intellectual property documents suitable for filing in one or more of plural target jurisdictions the

method comprising: registering for each of plural associates (Patent Attorney Directory), at least one target jurisdiction and a computer readable encoding of a plurality of form documents corresponding to target jurisdiction and associate specifications (www.inventnet.com, 11/7/1996).

6. InventNet.com fails to distinctly disclose distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates.
7. WIPO teaches distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates or electronically (PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included distributing at least a portion of the form documents to an originating filer for use in preparation of the intellectual property documents suitable for filing by respective ones of the associates or electronically, as disclosed by WIPO in the system disclosed by InventNet.com, for the advantage of operating an information service to facilitate preparation of intellectual property documents where users have the ability to select from a list of registered associates, be supplied the necessary form documents, and have the associate file for intellectual property rights.
9. As per Claim 2, InventNet.com and WIPO disclose wherein the distribution is responsive to selection by the originating filer of one or more of the target jurisdictions and, for each

selected target jurisdiction, a respective one of the associates (InventNet.com: www.inventnet.com).

10. As per Claim 3, InventNet.com and WIPO disclose wherein the distribution includes periodic supply to the originating filer of computer readable encoding of at least a portion of the form documents for each of plural associates (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
11. As per Claim 4, InventNet.com and WIPO disclose wherein the distribution is encoded by and/or transmitted in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electrical storage medium and a network, wireline, wireless or other communications medium (InventNet.com: www.inventnet.com).
12. As per Claim 6, InventNet.com and WIPO disclose wherein the selection at the originating node includes selection of two or more target jurisdictions (InventNet.com: www.inventnet.com).
13. As per Claim 7, InventNet.com and WIPO disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: formatting requirements for filing of the intellectual property filing in the target jurisdiction; and an encoding of at least one filing suitable for filing at target jurisdiction (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

14. As per Claim 8, InventNet.com and WIPO disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: information characterizing one or more data fields for which values specific to the intellectual property filing are to be supplied from the originating node to allow preparation of documents for filing in the selected at least one target jurisdiction by the selected at least one associate (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
15. As per Claim 9, InventNet.com and WIPO disclose wherein for each selected at least one target jurisdiction and corresponding at least one associate, the particularized requirements include: an encoding of at least one paper required by the selected at least one associate (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
16. As per Claim 10, InventNet.com and WIPO disclose wherein the originating node includes a computer of a managing attorney or intellectual property owner; and wherein at least a portion of the target nodes include a computer of a respective associate configured to electronically receive at least a portion of the intellectual property filing from the originating node via the intellectual property filing portal (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
17. As per Claim 11, InventNet.com and WIPO disclose wherein the originating node includes a web browser; wherein the intellectual property filing portal includes a web server; and wherein the selection of at least one target jurisdiction and at least one

associate, the supplying of the particularized requirements, and the receipt of the one or more intellectual property filings prepared in accordance with the particularized requirements are achieved, at least in part, using internet protocol traffic between the web browser and the web server (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

18. As per Claim 12, InventNet.com and WIPO disclose wherein the intellectual property filing portal is further responsive to registration by one or more of the associates of particularized requirements for the corresponding at least one target jurisdiction; wherein the supplied particularized requirements include those registered by the selected at least one associates (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
19. As per Claim 13, InventNet.com and WIPO disclose wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network (InventNet.com: www.inventnet.com).
20. As per Claim 14, InventNet.com and WIPO disclose wherein the received intellectual property filings include one or more of: a computer readable encoding of a technical document including specification and claims formatted in accordance with the supplied particularized requirements of at least a first of the selected target jurisdictions; and a computer readable encoding of information for completion of a filing paper, request for examination or transmittal in accordance with the supplied particularized requirements of the first selected target jurisdiction and the selected associate therefore (InventNet.com:

www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual,
<http://pcteasy.wipo.int/en/index.html>).

21. As per Claim 16, InventNet.com and WIPO disclose registering one or more associates for the making of intellectual property filing in respective one or more target jurisdictions, the registering including updating a data store with computer readable encodings of one or more form documents specific to at least one associate and the respective at least one target jurisdiction (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
22. As per Claims 17 and 23, InventNet.com and WIPO disclose providing one or more quoted fees associated with both the at least one target jurisdiction and the at least one associate, wherein the supplying of the computer readable encoding of one or more form documents is contingent upon authorization by the user of the quoted fees (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
23. As per Claim 18, InventNet.com and WIPO disclose providing one ore more quoted fees associated with both the at least one target jurisdiction and the at least one associate substantially coincident with the selection; and transacting the quoted fees substantially coincident with the one or more of the selection, the receiving of one or more documents and the filing in the selected target jurisdiction (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
24. As per Claim 19, InventNet.com and WIPO disclose wherein the transacting includes one or more of debiting a deposit account, executing a wire transfer, and electronically

authorizing payment of the quoted fees using a credit card, debit card or other payment system (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

25. As per Claim 20, InventNet.com and WIPO disclose responsive to the selection by the user of the at least one target jurisdiction and the at least one associate corresponding thereto, retrieving a computer readable encoding of target jurisdiction filing requirements for technical documents; and preparing one or more technical documents of the one or more documents suitable for filing in accordance with the target jurisdiction filing requirements for technical documents (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
26. As per Claim 21, InventNet.com and WIPO disclose supplying the user, via the network, with the computer readable encoding of target jurisdiction filing requirements for technical documents; and performing the preparing at the user's site using the computer readable encoding of target jurisdiction filing requirements; and receiving from the user, via the network, the prepared one or more technical documents for forwarding to the selected at least one associate (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
27. As per Claim 24, InventNet.com and WIPO disclose populating the one ore more target jurisdiction and associate-specific documents with matter specific information (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

28. As per Claim 26, InventNet.com and WIPO disclose for each selected target jurisdiction: completing the one or more form documents in accordance with matter specific information retrieved from a data store (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
29. As per Claim 27, InventNet.com and WIPO disclose selecting the respective associate from amongst a set of supported associates (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
30. As per Claims 28-30, InventNet.com and WIPO disclose wherein the obtaining is from an intellectual property filing portal; and wherein the supplying for transfer includes supplying a computer readable encoding to the intellectual property filing portal for forwarding to the respective associate (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
31. As per Claim 31, InventNet.com and WIPO disclose wherein the obtaining and the supplying are via a network; and wherein the supplied portion of the set of filing documents includes at least a computer readable encoding of one or more technical documents (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
32. As per Claim 32, InventNet.com and WIPO disclose wherein the supplied portion of the set of filing documents includes one or more technical documents and completed ones of the one or more form documents (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

33. As per Claim 34, InventNet.com and WIPO disclose wherein the transforming is further in accordance with a computer readable encoding if the selected attorney or agent's requirements (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
34. As per claims 35, InventNet.com and WIPO disclose wherein the intellectual property application data includes contents of a priority application (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
35. As per claims 36, InventNet.com and WIPO disclose wherein the intellectual property application data includes data retrieved from a docket system (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
36. As per Claim 37, InventNet.com and WIPO disclose wherein the electronically transmitting is via an information service intermediary; and further comprising receiving from the information service intermediary at least the computer readable encoding of filing requirements for the selected one or more target jurisdictions (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
37. As per Claim 38, InventNet.com and WIPO disclose wherein the electronically transmitting is via an information service intermediary; and wherein the transforming is performed by the information service intermediary (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

38. As per Claim 39, InventNet.com and WIPO disclose wherein the one or more intellectual property related documents include at least one of an intellectual property application, an amendment, a transmittal paper, an appointment of agent, and legalization paper (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
39. As per Claim 40, InventNet.com and WIPO disclose representing the intellectual property application data in a target-neutral format prior to the transforming thereof (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
40. As per Claim 42, InventNet.com and WIPO disclose for each target jurisdiction selection, receiving a selection of at least one attorney and/or agent corresponding thereto, wherein the computer readable encoding of filing requirements includes attorney- and/or agent-specific requirements for at least the selected at least one attorney and/or agent (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
41. As per Claim 43, InventNet.com and WIPO disclose transmitting, for at least one of the selected one or more target jurisdictions, a computer readable encoding of a technical document for filing in the selected one or more selected target jurisdiction (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
42. As per Claim 45, InventNet.com and WIPO disclose a communications interface for transmitting the transformed intellectual property application data and at least one

additional document for filing (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

43. As per Claim 46, InventNet.com and WIPO disclose a data store, responsive to the retrieval interface, for storing the intellectual property application data (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
44. As per Claim 47, InventNet.com and WIPO disclose wherein the target includes a target jurisdiction and/or convention; and wherein the target requirement data includes filing requirements for the target jurisdiction and/or convention (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
45. As per Claim 48, InventNet.com and WIPO disclose wherein the target further includes an attorney and/or agent; and wherein the target requirement data further includes attorney- and/or agent-specific requirements (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
46. As per Claim 49, InventNet.com and WIPO disclose wherein the intellectual property application data includes priority application data content corresponding to a previously filed intellectual property application (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
47. As per Claim 50, InventNet.com and WIPO disclose wherein the target-specific intellectual property application-filing format is an electronic format for transmission to

the target (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

48. As per Claim 51, InventNet.com and WIPO disclose an information system embodied as a client application executable on a originating computer and implementing: the selection facility, the retrieval interface to intellectual property application data, the retrieval interface to requirement data; and the filing preparation facility and including a communications interface to a server application; and wherein at least the requirement data is hosted by the server application (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
49. As per Claim 53, InventNet.com and WIPO disclose wherein the selected code, the retrieval code, the document preparation code and filing initiation code are all executable on a same processor (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
50. As per Claim 55, InventNet.com and WIPO disclose registering individual one or ones of the associates for fulfillment of intellectual property filing in respective of the target jurisdictions (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).
51. As per Claim 57, InventNet.com and WIPO disclose wherein, the one or more target jurisdiction and associate-specific documents include one or more technical documents (InventNet.com: www.inventnet.com) (WIPO: PCT-Easy, User Reference Manual, <http://pcteasy.wipo.int/en/index.html>).

Response to Arguments

52. Applicant's arguments with respect to Claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.
53. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
54. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

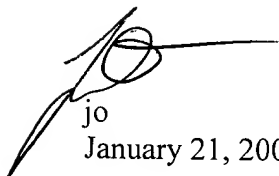
Conclusion

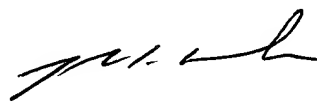
55. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
56. The following foreign patent is cited to show the best foreign prior art found by the examiner:

Japanese Pat. No. JP 11134399 A to Takano et al.

Takano discloses a system / method for preparing a description for a patent application and a recording medium recorded with a program for preparing a description for a patent application.

57. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.
58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
59. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


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January 21, 2003


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600